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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,986	06/25/2003	Anthony J. Wasilewski	A-9233	3781

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EXAMINER

CHAI, LONGBIT

ART UNIT	PAPER NUMBER
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2431

NOTIFICATION DATE	DELIVERY MODE
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04/10/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTOmail@sciatl.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/602,986	<b>Applicant(s)</b> WASILEWSKI ET AL.	
	<b>Examiner</b> LONGBIT CHAI	<b>Art Unit</b> 2431	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

1. Currently pending claims are 1 – 22.

### ***Response to Arguments***

2. Applicant asserts that “for a proper rejection under 35 USC § 112(1), MPEP2163 indicates that the examiner has the initial burden of presenting evidence or reasoning to explain why persons skilled in the art would not recognize in the original disclosure a description of the invention defined by the claims” (Remarks: Page 5). Examiner respectfully notes there is *no new matter issue* regarding whether “applicant was in possession of the claimed invention as a whole *at the time the application was filed* (as per disclosure of "claims or abstract" of this instant application filed on 6/25/2003)”; however, the parents do not support the instant claims since there is no disclosure of the invention such as selecting for partial encryption using an identifier (see detail below @ Item# 3) and accordingly, prior-art rejections, Cadelore / Unger, were made as per claimed priority dates on the first non-final submitted on 11/19/2008, which includes a set of dual (i.e. two different) 102(e) rejections, on page 3 / 4, where one reference is Cadelore (i.e. U.S. Patent 7,376,233) and the other reference is Unger (i.e. PG-PUB 2003/0026423 or U.S. Patent 7,336,787).

3. As per claim 1, Applicant refers to DES and 3DES of Figure 3 in conjunction with associated disclosures and assets “it is clear that the specification supports the above-recited claim 1 elements” (Remarks: Page 8 / 1<sup>st</sup> Para). Examiner respectfully disagrees because, according to Figure 3, a content key (i.e. Control Word (Element 319)), after being generated by a random number generator RNG (Element 317), is protected by using 3DES encryption technique (Element 321) and subsequently create a ECM message (Element 323) – this is

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simply a key-encryption-key technique (i.e. a content key encrypted by 3DES encryption).

Thereby, the priority dates of the parent applications do not support the disclosure of selecting for partial encryption using an identifier (see @ Item# 2), such as “*selecting for encryption a digital bit stream from a plurality of digital bit streams using an identifier*” as recited in the claim and as such Applicant's arguments are respectfully traversed.

4. With respect to priority date, upon further reviews by Office, the Affidavits filed on 1 June 2007 to support the critical feature of the amended claim limitation (filed on 8/1/2006) in order to distinguish from the prior-arts is not persuasive because (a) an Affidavits filed by one of the inventors is considered as self-interested, (b) the filed Affidavits merely bears a statement without providing clear and **specific evidence to substantiate the conclusive statements**, and (c) the beneficial priority date appears failing to support the claimed subject matter such as “selecting for encryption ... using a identifier (amended on 8/1/2006)”. Therefore, the beneficial priority date has been denied until such that Applicant can show supports since the priority date is not supported in the sense what is being claimed and the effective filing date of the claims is thus the filing date of the instant application – i.e. 6/25/2003 (without the beneficial priority date).

5. Examiner notes, for **clarity** purpose, *the following events of action/response(s) are listed in a **timely order*** specially on this instant application as follows:

- (a) the original claims are corresponding to the claims when the instant application is originally filed on **25 June 2003**.
- (b) the original claim was amended as “selecting for encryption a digital bit stream from a plurality of digital bit streams using an identifier” filed on **1 August 2006**.
- (c) the Affidavits was subsequently filed on **1 June 2007** (on page 5):

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✓ Item# 17. A person of ordinary skill in the art would understand the next sentence of the paragraph to disclose an example of encrypting packets marked *with packet identifier PID* 705(a) and 705(b).

✓ Item# 18. A person of ordinary skill in the art would understand the seven sentences together, one following directly after the other, included in the same paragraph, to disclose "selecting for encryption a digital bitstream from a plurality of digital bit streams *using an identifier*."

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1 – 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Candelore et al. (U.S. Patent 7,376,233) – *with incorporated by reference* of Unger et al. (U.S. Patent 2003/0026423).

- ✓ **PART – I** (@ Claim 1 and 13): **Candelore** reference for U.S.C. 102(e) Rejection
- ✓ **PART – II** (@ Claim 1 and 13): **Unger** reference for U.S.C. 102(e) Rejection

### **PART – I** (@ Claim 1 and 13): **Candelore** reference for U.S.C. 102(e) Rejection

As per claim **1 and 13**, Candelore / Unger teaches a method for providing an instance in a conditional access system, the method comprising the steps of:

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**selecting for encryption a digital bit stream from a plurality of digital bit streams using an identifier** (Candelore: Column 3 Line 51 – 62, Column 6 Line 16 – 22 and Column 4 Line 3 – 16: PID is used by the selective encryption encoder to determine which packets are to be encrypted according a specific encryption method);

**encrypting the selected digital bit stream according to a first level encryption method to provide an encrypted instance** (Candelore: Column 4 Line 13 – 16: PID is used by the selective encryption encoder to determine which packets are to be encrypted according a specific encryption method);

**combining tire encrypted instance with the plurality of digital bit streams to provide a partially-encrypted bit stream** (Candelore: Column 6 Line 16 – 51); and  
**transmitting the partially-encrypted bit stream** (Candelore: Figure 1).

## **PART – II (@ Claim 1 and 13): Unger reference for U.S.C. 102(e) Rejection**

As per claim **1 and 13**, Candelore / Unger teaches a method for providing an instance in a conditional access system, the method comprising the steps of:

**selecting for encryption a digital bit stream from a plurality of digital bit streams using an identifier** (Unger: Para [0010] Line 1 – 7, Para [0037] Line 1 – 3, Para [0055] & Table 1: some implementation, as disclosed by Unger, of partial dual encryption involve duplicating only certain packets tagged with a given packet identifier PID – i.e. the critical packets required for encryption that involves duplicating to achieve dual encryption purpose are chosen only for those packets identified by (i.e. tagged with) a particular packet identifier PID);

**encrypting the selected digital bit stream according to a first level encryption method to provide an encrypted instance** (Unger: Table 1: EA = Encryption method A for legacy system and EB = Encryption method B for conventional system);

**combining tire encrypted instance with the plurality of digital bit streams to provide a partially-encrypted bit stream** (Unger: Figure 6: via a multiplex); and  
**transmitting the partially-encrypted bit stream** (Unger: Figure 6).

As per claim 2, 4, 14 and 15, Candelore / Unger teaches wherein the selecting step selects the digital bit stream by identifying a predetermined packet identifier (Candelore: Column 3 Line 51 – 62, Column 6 Line 16 – 22 and Column 4 Line 3 – 16) & (Unger: Para [0010] Line 1 – 7, Para [0037] Line 1 – 3).

As per claim 3, Candelore / Unger teaches all of the selected digital bit stream is encrypted according to the first level encryption method (Unger: Table 1 and Figure 6 / E318 & Para [0054], [0072] and [0073]).

As per claim 5, Candelore / Unger teaches a portion of the selected digital bit stream is encrypted, wherein the encrypted portion and an unencrypted portion of the selected digital stream are combined with the plurality of digital bit streams (Unger: Table 1 and Figure 6 / E322 & Para [0053] - [0058]).

As per claim 6, Candelore / Unger teaches the selected digital bit stream is a program (Unger: Table 1 and Para [0055]).

As per claim 7, Candelore / Unger teaches the selected digital bit stream is an elementary digital bit stream (Unger: Table 1, Para [0087], [0109] and [0010]).

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As per claim 8, Candelore / Unger teaches selecting more than one digital bit stream from the plurality of digital bit streams, wherein the more than one digital bit stream is identified by predetermined packet identifiers (Candelore: Column 3 Line 51 – 62, Column 6 Line 16 – 22 and Column 4 Line 3 – 16) & (Unger: Para [0010] Line 1 – 7, Para [0037] Line 1 – 3).

As per claim 9, Candelore / Unger teaches each of the more than one digital bit stream includes a distinct packet identifier, wherein the selecting step selects the more than one digital bit stream by identifying at least one of the distinct packet identifiers (Candelore: Column 3 Line 51 – 62, Column 6 Line 16 – 22 and Column 4 Line 3 – 16) & (Unger: Para [0010] Line 1 – 7, Para [0037] Line 1 – 3).

As per claim 10, Candelore / Unger teaches a portion of each of the more than one digital bit stream is encrypted according to the first level encryption method (Unger: Table 1 and Figure 6 / E318 & Para [0054], [0072] and [0073]).

As per claim 11, Candelore / Unger teaches all of the more than one digital bit stream is encrypted according to the first level encryption method (Unger: Table 1 and Figure 6 / E318 & Para [0054], [0072] and [0073]).

As per claim 12, Candelore / Unger teaches at least one of a portion of each of the more than one digital bit stream and all of the more than one digital bit stream is encrypted according to the first level encryption method (Unger: Table 1 and Figure 6 / E318 & Para [0054], [0072] and [0073]).

As per claim 19, Candelore / Unger teaches the at least one of the plurality of packets is selected by the packet identifier indicative of the audio stream (Candelore: Column 3 Line 51 –



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62, Column 6 Line 16 – 22 and Column 4 Line 3 – 16) & (Unger: Para [0010] Line 1 – 7, Para [0037] Line 1 – 3).

As per claim 20, Candelore / Unger teaches the encrypted portion includes at least one of the plurality of packets associated with the data stream (Unger: Para [0109] and [0010]).

As per claim 21, Candelore / Unger teaches the at least one of the plurality of packets is selected by the packet identifier indicative of the data stream (Candelore: Column 3 Line 51 – 62, Column 6 Line 16 – 22 and Column 4 Line 3 – 16) & (Unger: Para [0010] Line 1 – 7, Para [0037] Line 1 – 3).

As per claim 22, Candelore / Unger teaches the encrypted portion includes at least one of the plurality of packets associated with at least one of the video stream, the audio stream, and the data stream (Unger: Table 1, Para [0087], [0109] and [0010]).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to LONGBIT CHAI whose telephone number is (571)272-3788. The examiner can normally be reached on Monday-Friday 9:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R. Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Longbit Chai/

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3/12/2009